

ESTTA Tracking number: **ESTTA594268**

Filing date: **03/24/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	MSC Services Corp.
Granted to Date of previous extension	03/22/2014
Address	75 Maxess Road Melville, NY 11747 UNITED STATES

Name	Sid Tool Co., Inc. (d/b/a MSC Industrial Supply Co.)		
Entity	Corporation	Citizenship	New York
Address	75 Maxess Road Melville, NY 11747 UNITED STATES		

Attorney information	Michael R. Graif Curtis, Mallet-Prevost, Colt & Mosle LLP 101 Park Avenue New York, NY 10178 UNITED STATES trademark@curtis.com Phone:212-696-6000
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Applicant Information

Application No	86124372	Publication date	01/21/2014
Opposition Filing Date	03/24/2014	Opposition Period Ends	03/22/2014
Applicant	Pro-Mart Industries, Inc. 17421 Von Karman Irvine, CA 92614 CANADA		

Goods/Services Affected by Opposition

Class 006. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Metal goods, namely, metal laundry sorting bins, metal tool boxes and metal storage containers, metal clothing and accessory hooks and clips, metal closet organizer components and accessories sold individually in the nature of baskets of common metal, metal bins, free-standing and stackable metal boxes, and containers of metal for transport; ironing accessories in the nature of metal hangers for ironing boards

Class 012. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Carts, namely, laundry carts and shopping carts, industrial rolling carts for cargo and mobile storage carts for industrial use, non-motorized carts for transporting laundry garments; and non-motorized carts for transporting and sorting laundry; collapsible racks for vehicles for luggage

Class 020. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Furniture, namely, metal and non-metal closet storage shelves, storage racks and wardrobes; closet accessories, namely, clothes hangers, skirt hangers, coat hangers, coat racks, tie racks, sweater storage racks, shoe racks, shoe cabinets, shelf-contained modular and non-modular plastic storage units consisting of storage shelves and drawers, plastic storage crates, plastic drawer lining material, stackable storage shelves and racks, steel storage shelving, heavy duty shelving and storage racks, and upright shelves, all for use in closets; garment storage racks, magazine racks, shoe racks, wine racks, collapsible non-metal chests for use under the bed; non-metal fabric hanging organizers for use in closets; hanging towel racks, free-standing closets; plastic hooks for hanging on doors; home storage and organizing products, namely, pant hangers with articulated and spring-urged clamped members for holding pants, hanger caddies consisting primarily of hangers for cloths, non-metal garment and fashion accessory hooks and clips, boot racks, garment racks, pant racks, skirt racks, plastic boxes for storing a variety of clothing and footwear and bedding items, baskets for transporting goods for commercial purposes, over-the-door non-metal hooks, over-the-door non-metal fabric hanging organizers; hanging units consisting of garment hangers, drawers, cabinets, non-metal hooks, cupboards, clothes rods; and storage bins furniture, namely, free-standing prefabricated closet organization systems made of wood and metal; baker's racks containing shelves and bins for food and household storage, food preparation and food serving; tables for displaying laundry bags; hand-operated non-metal retractable reels for storage of clothes lines

Class 021. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Housewares, namely, clothes drying racks, and collapsible storage containers for domestic use, and containers for household or kitchen use; cutting boards; lazy susans; tea canisters for household and kitchen use; willow storage baskets; tumblers, namely, toothbrush holders, dish drying racks; and trash cans; laundry accessories, namely, ironing boards; shaped ironing board covers, shaped ironing board covers containing pads therein; clothes pins; laundry sorters for household use featuring metal, plastic or wood framed structures with canvas or fabric bags or containers, laundry baskets, stackable clothes drying racks, free-standing, stackable and non-stackable laundry clothes drying racks; adhesive lint rollers; lint brushes for clothing; kitchen organizers and accessories, namely, dish drying racks, countertop holders for paper towels, spice racks, non-electric kitchen containers not being of precious metal; portable plastic containers for storing household and kitchen goods, all purpose portable household containers, containers for household use, containers for household or kitchen use, collapsible storage containers for domestic use; laundry bins for domestic or household use, for use in sorting laundry; laundry hampers for domestic or household use; lockable non-metal household containers for storage or transport of food


Class 022. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Sacks and bags, namely, multi-purpose cloth bags, plastic bags with one-way valves in which air is evacuated for storing clothing and/or bedding, laundry bags; mesh and non-mesh laundry bags; laundry wash bags for holding clothes while in washing machines, mesh bags for storage, and hanging mesh nets for storing toys and household items; laundry accessories, namely, laundry wash bags; tarpaulins, garment bags for storage, shoe bags for storage; clothes lines; laundry organizers in the nature of cloth bags for laundry; mesh pressing pads to protect clothing from shine and scorch marks during ironing; cloth bags for storage of artificial Christmas trees; cloth bags for storage of wreaths; cloth bags for general storage; closet organizer components and accessories sold individually, namely, cloth and vinyl garment bags for storage; household cloth bags for storing laundered clothes

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Priority and likelihood of confusion under common law; MSC Services and SID Tool have acquired common law rights to the marks in question that are superior to any rights of the applicant


Marks Cited by Opposer as Basis for Opposition


U.S. Application No.	77968707	Application Date	03/25/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	WORKSMART		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 022. First use: First Use: 2010/09/15 First Use In Commerce: 2010/09/15 Ropes and cords for lifting and securing loads, namely, ropes, non-metal lifting slings, slings and tie-downs		


U.S. Application No.	77968529	Application Date	03/25/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	WORKSMART		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 0 First Use In Commerce: 0 Lighting fixtures, lighting tracks, heating installations, electric space heaters, ventilating exhaust fan, ventilatingfans for commercial and industrial use,ventilating louvers and water conditioning units and pipes sold as a unit with the water closets and water conditioningunits; reinforcements for water-pipes, namely, shower control valves, tub control valves, plumbing fittings, namely, bibs, cocks, traps, couplers, drains, valves and spouts		

U.S. Application No.	77968650	Application Date	03/25/2010
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	WORKSMART
Design Mark	
Description of Mark	NONE
Goods/Services	Class 017. First use: First Use: 0 First Use In Commerce: 0 Air hoses; plastic hoses for plumbing; watering hoses; non-metallic hoses and pipes; plastic tubes for plumbing; rubbertubes and pipes; pipe fittings comprised primarily of plastic

U.S. Application No.	77968461	Application Date	03/25/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	WORKSMART		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 008. First use: First Use: 0 First Use In Commerce: 0 Manually operated lifting equipment andlifting apparatuses, namely hand operated lifting jacks; hand tools, namely, wire cutters, steel strap cutters, diagonal cutters, bolt cutters, flush cutters, cable cutters, hammers, hacksaws and hacksaw blades, hex keys, hex key sets, insulated pliers, insulated screwdrivers, insulated wrenches, insulated hex keys, insulated socket wrenches, utility knivesand replacement blades, snap blade knives and replacement blades, pocket knives; multi-function hand tools comprised of screwdrivers, knives, can openers, pliers, scissors, files, rulers, wire crimpers, lanyards and awls; hand tools, namely, nutdrivers, pliers, punches, chisels,ratchet wrenches, ratchet wrenches sets, screwdrivers, scissors, shears, socketwrenches, socket sets and socket wrenches; tool sets comprised of hand tools, namely, wrenches, socket wrenches, saws, pliers, hammers, knives, wire cutters, screwdrivers, chisels, punches; hand tools, namely, torque wrenches, torque screwdrivers, wrenches and wrench sets, wire strippers, wire crimpers		

U.S. Application No.	77968369	Application Date	03/25/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	WORKSMART		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 006. First use: First Use: 0 First Use In Commerce: 0 Metal building materials, namely, soffits, fascia, wall framing, metal sheets, crossbeams, retaining tubes, reinforcing material of metal for building purposes, metal cladding, metal roofing, metal flooring, metal floor tiles and metal partitions; metal hardware, namely, springs, nuts, washers, pulleys, pulls, nails, screws, locks, hinges of metal, metal hooks, metal fastening collars, metal cables and wires not for electrical purposes, metal cable rollers and reels, metal cable holders, metal rivets and pins, metal threaded rods, non-electric metal terminals, namely, wire clamps, quick-release fasteners; pipes and tubes of metal; industrial metal hoses and metal hose fittings; metal hoses for plumbing use; general purpose storage containers made of metal		

U.S. Application No.	85448652	Application Date	10/17/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	WORKSMART		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 0 First Use In Commerce: 0 Tool bags sold empty		

Attachments	77968707#TMSN.jpeg(bytes) 77968529#TMSN.jpeg(bytes) 77968650#TMSN.jpeg(bytes) 77968461#TMSN.jpeg(bytes) 77968369#TMSN.jpeg(bytes) 85448652#TMSN.jpeg(bytes) ProMart Smart Works.pdf(22996 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/ Michael R. Graif
Name	Michael R. Graif
Date	03/24/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. : 86124372
Mark : SMART WORKS
International Classes : 006, 012, 020, 021 and 022
Applicant : Pro-Mart Industries, Inc.
Filed : November 20, 2013
Published : January 21, 2014

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MSC SERVICES CORP.; SID TOOL CO., INC.	:	
(D/B/A MSC INDUSTRIAL SUPPLY CO.)	:	
	:	
Opposers,	:	
	:	
against	:	Opposition No. _____
	:	
PRO-MART INDUSTRIES, INC.,	:	
	:	
Applicant.	:	
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NOTICE OF OPPOSITION

MSC Services Corp. and Sid Tool Co., Inc. (d/b/a MSC Industrial Supply Co.), are corporations organized under the laws of the State of New York, located and doing business at 75 Maxess Road, Melville, New York 11747 (the “Opposers”), and believe that they would be damaged by the registration of United States Trademark Application Serial No. 86124372 (the “Opposed Application”) for the mark SMART WORKS. The Opposed Application was filed by the Pro-Mart Industries, Inc. (the “Applicant”) on November 20, 2013 and published for opposition on January 21, 2014 in:

International Class 006 and United States Classes 002, 012, 013, 014, 023, 025 and 050 for “Metal goods, namely, metal laundry sorting bins, metal tool boxes and metal storage containers, metal clothing and accessory hooks and clips, metal closet organizer components and accessories sold individually in the nature of baskets of common metal, metal bins, free-standing and stackable

metal boxes, and containers of metal for transport; ironing accessories in the nature of metal hangers for ironing boards”;

International Class 012 and United States Classes 019, 021, 023, 031, 035 and 044 for “Carts, namely, laundry carts and shopping carts, industrial rolling carts for cargo and mobile storage carts for industrial use, non-motorized carts for transporting laundry garments; and non-motorized carts for transporting and sorting laundry; collapsible racks for vehicles for luggage”;

International Class 012 and United States Classes 019, 021, 023, 031, 035 and 044 for “Furniture, namely, metal and non-metal closet storage shelves, storage racks and wardrobes; closet accessories, namely, clothes hangers, skirt hangers, coat hangers, coat racks, tie racks, sweater storage racks, shoe racks, shoe cabinets, shelf-contained modular and non-modular plastic storage units consisting of storage shelves and drawers, plastic storage crates, plastic drawer lining material, stackable storage shelves and racks, steel storage shelving, heavy duty shelving and storage racks, and upright shelves, all for use in closets; garment storage racks, magazine racks, shoe racks, wine racks, collapsible non-metal chests for use under the bed; non-metal fabric hanging organizers for use in closets; hanging towel racks, free-standing closets; plastic hooks for hanging on doors; home storage and organizing products, namely, pant hangers with articulated and spring-urged clamped members for holding pants, hanger caddies consisting primarily of hangers for cloths, non-metal garment and fashion accessory hooks and clips, boot racks, garment racks, pant racks, skirt racks, plastic boxes for storing a variety of clothing and footwear and bedding items, baskets for transporting goods for commercial purposes, over-the-door non-metal hooks, over-the-door non-metal fabric hanging organizers; hanging units consisting of garment hangers, drawers, cabinets, non-metal hooks, cupboards, clothes rods; and storage bins furniture, namely, free-standing prefabricated closet organization systems made of wood and metal; baker's racks containing shelves and bins for food and household storage, food preparation and food serving; tables for displaying laundry bags; hand-operated non-metal retractable reels for storage of clothes lines”;

International Class 012 and United States Classes 019, 021, 023, 031, 035 and 044 for “Housewares, namely, clothes drying racks, and collapsible storage containers for domestic use, and containers for household or kitchen use; cutting boards; lazy susans; tea canisters for household and kitchen use; willow storage baskets; tumblers, namely, toothbrush holders, dish drying racks; and trash cans; laundry accessories, namely, ironing boards; shaped ironing

board covers, shaped ironing board covers containing pads therein; clothes pins; laundry sorters for household use featuring metal, plastic or wood framed structures with canvas or fabric bags or containers, laundry baskets, stackable clothes drying racks, free-standing, stackable and non-stackable laundry clothes drying racks; adhesive lint rollers; lint brushes for clothing; kitchen organizers and accessories, namely, dish drying racks, countertop holders for paper towels, spice racks, non-electric kitchen containers not being of precious metal; portable plastic containers for storing household and kitchen goods, all purpose portable household containers, containers for household use, containers for household or kitchen use, collapsible storage containers for domestic use; laundry bins for domestic or household use, for use in sorting laundry; laundry hampers for domestic or household use; lockable non-metal household containers for storage or transport of food”; and

International Class 012 and United States Classes 019, 021, 023, 031, 035 and 044 for “Sacks and bags, namely, multi-purpose cloth bags, plastic bags with one-way valves in which air is evacuated for storing clothing and/or bedding, laundry bags; mesh and non-mesh laundry bags; laundry wash bags for holding clothes while in washing machines, mesh bags for storage, and hanging mesh nets for storing toys and household items; laundry accessories, namely, laundry wash bags; tarpaulins, garment bags for storage, shoe bags for storage; clothes lines; laundry organizers in the nature of cloth bags for laundry; mesh pressing pads to protect clothing from shine and scorch marks during ironing; cloth bags for storage of artificial Christmas trees; cloth bags for storage of wreaths; cloth bags for general storage; closet organizer components and accessories sold individually, namely, cloth and vinyl garment bags for storage; household cloth bags for storing laundered clothes”.

Opposers hereby oppose the Opposed Application.

As grounds for opposition, Opposers assert that:

1. Opposers market, distribute and sell a variety of tools, industrial products, storage units, containers, bags, storage hooks and closet rods, carts, trash cans and bags, and maintenance, repair and operations products (“MRO products”) throughout the United States. In particular, Opposers market, distribute and sell a variety of products under the mark WORKSMART, including containers, tool boxes, storage furniture, storage systems, tool

cabinets, shelving systems, carts and cart accessories, bags, tools, workstations, safety supplies, and MRO products.

2. Opposers have continuously made commercial use of WORKSMART as a trademark throughout the United States since at least February 2010.

3. By virtue of their continuous use of the WORKSMART mark and trade name in commerce, Opposers have acquired common law rights in the WORKSMART mark and trade name. Opposers have expended significant amounts of time, money and effort in promoting and advertising the WORKSMART mark and trade name as well as the products and services distributed, marketed and sold thereunder. Opposers' WORKSMART mark and trade name are famous and consumers have come to recognize the WORKSMART mark and trade name as identifiers of Opposers' products and services and as a single source of origin.

4. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77968707 (the "707 Application") for the mark WORKSMART for "Ropes and cords for lifting and securing loads, namely, non-metal belts, webbings, lifting bands, ropes, nets, non-metal lifting slings, raising bands as well as parts thereof sold as a unit with the goods; bands made of canvas for lifting and securing loads" in International Class 022 and United States Classes 02, 03, 07, 19, 22, 42 and 50. Opposer MSC Services filed the 707 Application on March 25, 2010 and the United States Patent and Trademark Office (the "USPTO") published it for opposition on January 11, 2011. Opposer Sid Tool Co., Inc. is a licensee of the 707 Application.

5. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77968529 (the "529 Application") for the mark WORKSMART for "Lighting fixtures, lighting tracks, heating installations, electric space heaters, ventilating exhaust fan, ventilating

fans for commercial and industrial use, ventilating louvers and water conditioning units and pipes sold as a unit with the water closets and water conditioning units; reinforcements for water-pipes, namely, shower control valves, tub control valves, plumbing fittings, namely, bibs, cocks, traps, couplers, drains, valves and spouts” in International Class 011 and United States Classes 13, 21, 22, 31 and 34. Opposer MSC Services filed the 529 Application on March 25, 2010 and the USPTO published it for opposition on January 11, 2011. Opposer Sid Tool Co., Inc. is a licensee of the 529 Application.

6. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77968650 (the “650 Application”) for the mark WORKSMART for “Air hoses; plastic hoses for plumbing; watering hoses; non-metallic hoses and pipes; plastic tubes for plumbing; rubber tubes and pipes; pipe fittings comprised primarily of plastic” in International Class 017 and United States Classes 01, 05, 12, 13, 35 and 50. Opposer MSC Services filed the 650 Application on March 25, 2010 and the USPTO published it for opposition on January 4, 2011. Opposer Sid Tool Co., Inc. is a licensee of the 650 Application.

7. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77968461 (the “461 Application”) for the mark WORKSMART for “Manually operated lifting equipment and lifting apparatuses, namely hand operated lifting jacks; hand tools, namely, wire cutters, steel strap cutters, diagonal cutters, bolt cutters, flush cutters, cable cutters, hammers, hacksaws and hacksaw blades, hex keys, hex key sets, insulated pliers, insulated screwdrivers, insulated wrenches, insulated hex keys, insulated socket wrenches, utility knives and replacement blades, snap blade knives and replacement blades, pocket knives; multi-function hand tools comprised of screwdrivers, knives, can openers, pliers, scissors, files, rulers, wire crimpers, lanyards and awls; hand tools, namely, nutdrivers, pliers, punches, chisels, ratchet

wrenches, ratchet wrenches sets, screwdrivers, scissors, shears, socket wrenches, socket sets and socket wrenches; tool sets comprised of hand tools, namely, wrenches, socket wrenches, saws, pliers, hammers, knives, wire cutters, screwdrivers, chisels, punches; hand tools, namely, torque wrenches, torque screwdrivers, wrenches and wrench sets, wire strippers, wire crimpers” in International Class 008 and United States Classes 023, 028 and 44. Opposer MSC Services filed the 461 Application on March 25, 2010. Opposer Sid Tool Co., Inc. is a licensee of the 461 Application.

8. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 77968369 (the “369 Application”) for the mark WORKSMART for “Metal building materials, namely, soffits, fascia, wall framing, metal sheets, crossbeams, retaining tubes, reinforcing material of metal for building purposes, metal cladding, metal roofing, metal flooring, metal floor tiles and metal partitions; metal hardware, namely, springs, nuts, washers, pulleys, pulls, nails, screws, locks, hinges of metal, metal hooks, metal fastening collars, metal cables and wires not for electrical purposes, metal cable rollers and reels, metal cable holders, metal rivets and pins, metal threaded rods, non-electric metal terminals, namely, wire clamps, quick-release fasteners; pipes and tubes of metal; industrial metal hoses and metal hose fittings; metal hoses for plumbing use; general purpose storage containers made of metal” in International Class 006 and United States Classes 02, 12, 13, 14, 23, 25 and 50. Opposer MSC Services filed the 369 Application on March 25, 2010 and the USPTO published it for opposition on September 10, 2013. Opposer Sid Tool Co., Inc. is a licensee of the 369 Application.

9. Opposer MSC Services Inc. is the owner of U.S. Trademark Application Serial No. 85448652 (the “652 Application” and, together with the 707, 529, 650, 461 and 369 Applications, the “MSC WORKSMART Applications”) for the mark WORKSMART for “Tools

bags sold empty” in International Class 018 and United States Classes 02, 03, 22 and 41.

Opposer MSC Services filed the 652 Application on October 17, 2011 and the USPTO published it for opposition on October 16, 2012. Opposer Sid Tool Co., Inc. is a licensee of the 652 Application.

10. Upon information and belief, Applicant is a corporation organized under the laws of the State of California and is located and doing business at 317421 Von Karman Irvine, California 92614.

11. The Applicant’s SMART WORKS mark is substantially identical or confusingly similar to the Opposers’ WORKSMART marks. The Applicant’s reversal of the order of the words “work” and “smart” in Opposers’ WORKSMART marks and does not distinguish Applicant’s SMART WORKS mark from the Opposers’ WORKSMART marks. Nor does the pluralization of the word “work” in Applicant’s SMART WORKS mark distinguish that mark from Opposers’ WORKSMART marks.

12. Opposers use their WORKSMART marks in connection with marketing, distributing and selling products and services that are substantially similar and/or related to the goods and services listed in the Opposed Application.

13. In view of Opposers’ use of the WORKSMART mark before the Applicant’s claimed first use of its SMART WORKS mark, Opposers have rights in the names and marks WORKSMART and SMART WORKS that are superior and have priority to those of the Applicant.

14. If the Opposed Application is not withdrawn or amended so as to avoid a likelihood of confusion with Opposers’ WORKSMART marks, Opposers will suffer damage to their goodwill and reputation, and the public is likely to be confused or deceived with respect to

the source, origin, connection, affiliation, sponsorship or approval of Applicant's goods and/or Opposers' affiliation, sponsorship or connection with Applicant.

15. By reason of all of the foregoing, issuance of a registration to Applicant with respect to the Opposed Application would seriously damage Opposers.

WHEREFORE, Opposers pray that this opposition be sustained and that Application Serial No. 86124372 for the SMART WORKS mark be refused registration.

Respectfully submitted,

MSC Services Corp., Sid Tool Co., Inc.
(d/b/a MSC Industrial Supply Co.)

Dated: New York, New York
March 24, 2014

By: /s/ Michael R. Graif
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